REMARKS

Claim rejections - 35 USC § 103(a)

1.   In said office action the Examiner states that "Claims 1-9, 14-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, (U.S. Patent No. 5,961,645 and Baker hereinafter), in view of Smith, et al., (U.S. Patent No. 6,529,956 and Smith hereinafter)." Said rejections are respectfully traversed, and reconsideration of said rejections is hereby solicited.

2.   In the present Application the Applicant has provided, in the second and fourth paragraphs "Detailed Description of the Invention" thereof, a clear definition of "secret sites" which includes the word "secret" in combination with the word "sites", as known in the vocabulary of the internet. The Applicant has previously amended Claim 20 to be a third independent claim which includes limitations expressed as the definition of the term "secret site" in the second and fourth paragraphs of the Detailed Description of the Invention, to wit: 1) maintenance of a secret site URL as a secret from all but those users who have been given the knowledge thereof by the operator; 2) assignment of a secret site URL upon the user's request and in response to the user providing means by which they can be sufficiently identified; and 3) the unavailability of the knowledge of the existence, identity and URL of each of said secret sites to the public except through a process requiring a sufficient identification of the user. These are the features which define a secret site. None of these features are mentioned in Smith in any form, and therefore Claims 1, 14 and 20 should be allowed on the same ground.

3.   Throughout said Office Action the Examiner relies upon Smith, et al., (U.S. Patent No. 6,529,956 and Smith hereinafter) as the secondary reference to Baker (U.S. Patent No. 5,961,645 and Baker hereinafter) in rejecting all of the claims under 35 U.S.C. 103(a), albeit with some claims being rejected in reliance upon tertiary references: Klug et al. (U.S. Patent No. 5,790,785 and Klug hereinafter) for claims 11-13, and 19; and Waldner (U.S. Patent No. 6,141,413 and Waldner hereinafter) for claims 10 and 18. Therefore, if the Examiner's obviousness rejection of Baker in view of Smith is in error, the rejection of all claims is erroneous. In this regard it is to be noted that

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Baker is not cited as a reference for any *invention* disclosed in Baker, but *only* for the general features common to every internet operation, *and not prior art as contemplated by 35 U.S.C. 103(a) pertinent to the concept of "secret site"*. Moreover, the rejection based on Baker as prior art is erroneous, because such a rejection would also have to apply to the invention claimed in Smith as unpatentable under Section 103(a) itself (contrary to the presumption of patentability that is afforded an issued patent). Therefore, the Examiner's obviousness rejection, being thus completely dependent on specific features of Smith, appears to be an attempt to disguise what would be a patently erroneous anticipation rejection based on the Smith reference under Section 103(a). It is fundamental that had the Examiner found that an anticipation rejection based on Smith was proper, the Examiner was duty bound to make such a Section 102 rejection in said office action. It is clear that the Examiner could not find such a Section 102 rejection to be appropriate. This would follow from the fact that Smith does not meet the requirements of MPEP 2131 with respect to any of the claims of the present application. The only prior art that could possibly qualify as such under 35 U.S.C. 103(a) alleged by the Examiner to be pertinent is Smith. However, the Examiner does not allege Section 103(a) "obviousness" on the basis of the Smith reference alone.

4.   Following the admission that "Baker does not expressly disclose Internet operation including a system of secret internet web sites", the Examiner supports this Section 103(a) obviousness rejection with the following allegation:

"However, Smith discloses Internet operation including a system of secret internet web sites comprising:

one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation (i.e., Private URL), said secret sites being a part of said internet operation by which said internet operation may be accessed (Col. 15, lines 22-67)."

In fact Smith does not disclose as alleged by the Examiner. What Smith actually discloses with regard to the use of the term "PURL" is as follows (referred to as "Disclosures" for the purpose of

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reference thereto hereinafter):

(Disclosure 1): "An electronic document delivery system and methods of its use are provided. A document delivery architecture dynamically generates a private Uniform Resource Locator (URL) to distribute information. Each private URL ("PURL") uniquely identifies an intended recipient of a document, the document or set of documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of a document uses the PURL to retrieve the document." (Col. 2, Lines 28-35)

(Disclosure 2): "The invention provides a document delivery architecture which dynamically generates a private Uniform Resource Locator (URL) to distribute information. Each private URL ("PURL") uniquely identifies the intended recipient of a document, the document or set of documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of a document uses the PURL to retrieve a document (or documents)." (Col. 14, Lines 49-62)

(Disclosure 3): "PURLs are temporary, dynamically generated uniform resource locators which uniquely identify the intended recipient of a document and the document itself, as well attributes associated with the delivery of a document." (Col. 15, Lines 22-29, *emphasis supplied*)

(Disclosure 4): "The server dynamically generates a URL for each intended recipient of the document." (Col. 15, Lines 46-48)

(Disclosure 5): "PURL Implementation"
"First, consider the potential construction of a PURL. The following diagram outlines one specific example of a PURL:
"http://posta.tumbleweed.com/cgi/posta.dll?pu=0-233-33982-FIAAAV4

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"The above PURL denotes the following:

"Value	Meaning
"http:/	Use the HTTP protocol to access.
"posta.tumbleweed.com	Name of the HTTP server.
"cgi/posta.dll	Name of HTTP server extension.
"pu=0	Don't use a password.
"233	Store item Identifier.
"33982	Recipient Identifier.
"FIAAAV4	Key to access the document."

(Col. 16, Lines 36-51, *emphasis supplied*)

Disclosures 1-4 describe "PURL" as uniquely identifying one or more specific documents and the intended recipient thereof, and do not teach the secrecy of any internet site. Disclosure 5, in describing the construction of a "PURL", teaches only a system of variation in the extension of the URL for the publishing internet site, and not the use of a different and secret internet site identified by a completely different URL. In this latter respect it should be noted that the Applicant is not bound by terminology used and defined in another patent for a feature which is peculiar to that patent ("PURL" in Smith), or by the potentially confusing use of a term (URL in Smith). The term URL stands for universal resource locator, which is the way in which an internet site is identified, much as a telephone number identifies a telephone line. The URL is not the internet site *as such*, just as a telephone number is not the telephone line *as such*. This should be clear to the Examiner by reference to any text on the internet. As stated in "Harley Hahn Teaches the Internet", copyrighted in 1999 (by Harley Hahn and published by Que Coroporation, Library of Congress Catalog Card Number 97-81381; at pages 5 and 6):

"Broadly speaking, there are two types of programs used on the Internet: those that provide a service and those that request a service. A program that provides a service is called a SERVER. A program that requests a service is called a CLIENT."

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"A server is a program that offers a service, but we often use the word "server" to refer to the computer itself.

"For example, say you are being given a tour of a company. As you pass a room full of computers, the tour guide points to one of the machines and says, 'That's our Web server.' What he really means is, 'That's the computer that runs our Web server.'"

Also as stated in "Harley Hahn Teaches the Internet" (at page 22):

"A collection of related Web pages created by a particular person or organization is called a WEB SITE (sometimes spelled WEBSITE). . . ."

(and again at page 145:)

"Information on the Web is organized into WEB PAGES (although they are not real pages like in a book). A WEB SITE is a collection of related Web pages. . . . "

Further on the issue of the identity of internet sites and URLs "Harley Hahn Teaches the Internet" states (at page 82):

"At the beginning of this chapter, I said that every computer, every person and every resource on the Internet has its own address. We have already talked about two types of addresses: hostnames (for computers) and mail addresses (for people). We will now talk about the addresses we use to identify the vast number of resources available on the Net.

"The most popular resources on the Net are the many millions of Web pages stored on Web servers all over the world. Anyone with an Internet connection and a browser (Web client program) can access these pages. Of course, in order to fetch a Web page for you, your browser needs to know where to find the page. To describe the location of Web pages, we use a special type of address called a URL or UNIFORM RESOURCE LOCATOR. The name URL is pronounced as three separate letters, 'U-R-L'.

When we use a URL to specify the address of a particular resource, we say that the URL POINTS

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to that resource. For example, here is the URL that points to the main page of my Web site (don't worry about the details just yet):

"http://www.harley.com

"Web sites can consist of many separate Web pages, and, strictly speaking, a URL points only to a single page. However, when a URL points to the main page of a Web site, we often say, informally, that the URL points to the site as a whole. Thus, I might say that the URL above points to the Harley Hahn Web site."

5.   The independent claims of the present application clearly identify the term "internet web sites" with "computers programmed to operate as web servers" "hosting internet web sites", as distinguished from a "URL", which is used in those claims with respect to the "internet web sites" as "having" ("one or more of said internet web sites being secret sites *having*" URLs "which are not publicly associated with" an "internet operation"). It is clear that the Smith teaching of "PURLs" as constructed by extensions to a URL for a *particular* internet site does not, event remotely, imply the possibility of different internet sites whose identity are maintained as secret for the purpose of defeating denial of service attacks, the attempt by the Examiner (pages 4-12 of said office action) to equate irrelevant features of Smith to the "secret internet sites" of the present invention notwithstanding. Actually Smith specifically teaches to the contrary by refering to the construction of PURLs from a single internet site, which would presumably be open to denial of service attacks (the possibility of which are not considered in Smith at all).

6.   In said office action the Examiner states that "Claims 11-13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, (U.S. Patent No. 5,961,645 and Baker hereinafter), and Smith, et al., (U.S. Patent No. 6,529,956 and Smith hereinafter) in view of Klug et al., (U.S. Patent No. 5,790,785 and Klug hereinafter) ." The Examiner also states that "Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, (U.S. Patent No. 5,961,645 and Baker hereinafter), and Smith, et al., (U.S. Patent No. 6,529,956 and Smith

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hereinafter) in view of Waldner, (U.S. Patent No. 6,141,413 and Waldner hereinafter) ." Said rejections are respectfully traversed, and reconsideration of said rejections is hereby solicited.

This rejection is based upon the Examiner's allegation that Baker and Smith show all of the claimed limitations except for the particular features supplied by Klug and Waldner for the specific dependent claims to which they are applied. As shown in Section 3-5 of this response, it is clear that Baker and Smith do not include all of the limitations of Claims 1, 14, and 20, and therefore cannot serve the foundational references for the Examiner's obviousness rejections, even if Klug and Waldner disclose the missing limitations stated in the claims to which they are applied.

7.   The inapplicability of Baker and Smith as a foundational references aside, the Examiner's analysis in this case must begin with the first two of the four factual inquires enunciated Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) as a background for determining obviousness: determination of the scope and contents of the prior art; and ascertainment of the differences between the prior art and the claims in issue. It is respectfully suggested that the Examiner has failed to properly ascertain the background for carrying out any test for prima facie obviousness as required by the Graham factual inquiries with respect to Baker, and therefore any such determination of prima facie obviousness lacks the proper predicate therefor in any event.

8.   As correctly stated by the Examiner, "Baker doesn't expressly disclose" any feature related to the "secret sites" of the present invention. The Examiner, however, alleges other features which are missing in Baker to be disclosed in Smith, for all of the independent claims (as well as for the majority of the dependent claims), and in Klug and Waldner, for the remainder of the dependent claims, as the secondary and tertiary references for the obviousness rejection. With respect to the issue of the motivation to combine, there is no line of reasoning by the Examiner in any form as to how the teachings *actually present* in the references applied would be combined by an artisan of *any* level of skill. The Examiner's standard for determining a *prima facie* case of obviousness, in said Office Action", permits the Examiner to *select a mere aggregate* of references which are not

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associated by any form of suggestion, but which may contain the concepts and terms that are used in the present disclosure, as components for a *prima facie* case, without *any* rationale from those references or scientific principle as to why they should be combined to produce the invention. The Examiner is respectfully reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination. In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01. The Examiner is also respectfully reminded that a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. As stated earlier, not only has the Examiner failed to point out any such suggestion, but any such suggestion is also completely absent from the references applied. Moreover, by reason of the nature of Smith, Klug, and Waldner, there could not possibly be a motive to use "secret sites" as defined in the second and fourth paragraphs of the "Detailed Description of the Invention" of the present Application.
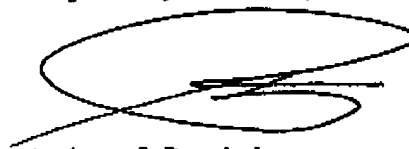
To establish a *prima facie* case of obviousness three basic criteria must be met: the first is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is the standard that was stated in slightly different terms in *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985): "To support the conclusion that the claimed invention is directed to obvious subject matter, either *the references must expressly or impliedly suggest* the claimed invention or the *examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references (emphasis supplied)." Not only are neither of the alternative grounds emphasized in the quotation of *Ex Parte Clapp* validly possible from the references applied to the present disclosure, because of

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the erroneous analysis of their substance, but neither of the alternative grounds are present in said Office Action *at all.* There is no suggestion whatever in the references applied, express or implied, for the use of the features of Smith, Klug, and Waldner in Baker, and there is no line of reasoning by the Examiner in any form as to how the teachings *actually present* in the references applied would be combined by an artisan of *any* level of skill.

From the foregoing analysis of said Office Action it is clear that the allegation of *prima facie* obviousness of the present invention is unfounded under the Graham factual inquiries, and otherwise does not comply in any of the assertions made in said Office Action with the requirements of MPEP 2141-2144.

In view of the above, each of the presently pending claims in this application are considered patentable over the references applied. Accordingly, the Examiner is respectfully requested to reconsider his rejections and this application as amended.

Respectfully submitted,

Anthony I. Provitola,
Applicant

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Anthony I. Provitola

Signature:

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Amendment f the CLAIMS

What I claim as my invention is:

Claim 1. (currently amended) An internet operation including a system of secret internet web sites comprising:

(a) ~~a plurality of~~ <u>one or more</u> computers programmed to operate as <u>a plurality of</u> web servers;

(b) one or more of said web servers hosting internet web sites for said internet operation;

(c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;

(d) one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation;

said secret sites being a part of said internet operation by which said internet operation may be accessed.

Claim 2. (original) The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against cybervandalism.

Claim 3. (original) The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against denial-of-service attacks.

Claim 4. (original) The internet operation of Claim 1 wherein one or more of said secret sites are assigned to one or more users of said internet operation.

Claim 5. (original) The internet operation of Claim 1 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of the internet operation from all but those users who have been given the knowledge thereof by said operator.

Claim 6. (original) The internet operation of Claim 1 wherein the URL of a secret site is acquired

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by a user through assignment to a user by an entity authorized by the operator.

Claim 7. (original) The internet operation of Claim 1 wherein a secret site is one whose existence, identity and URL are learned by a user only through the process of subscription.

Claim 8. (original) The internet operation of Claim 1 wherein the user is free to contact and use the main site anonymously as permitted and desired.

Claim 9. (original) The internet operation of Claim 1 wherein a user may subscribe for a secret site URL while the main site is under attack.

Claim 10. (original) The internet operation of Claim 1 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL.

Claim 11. (previously presented) The internet operation of Claim 1 wherein subscription by a user during an attack is through another internet operation which is independent of the internet operation which includes said main sites.

Claim 12. (original) The internet operation of Claim 1 wherein a reserve of secret sites is maintained that become available to the users of said internet operation in the event of an emergency created by an attack.

Claim 13. (original) The internet operation of Claim 1 wherein the secret site program queries the user for the identification, verifies the information, and proceeds to assign one of the secret site URLs to the user.

Claim 14. (currently amended) A system of secret internet web sites, comprising:
(a) a plurality of one or more computers programmed to operate as a plurality of web servers;
(b) one or more of said web servers hosting internet web sites for an internet operation;

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(c) one or more of said internet web sites being secret sites having universal resource locators

(URLs) which are not publicly associated with any internet operation;

which are operated to provide access to internet operations of other operators of internet web sites.

Claim 15. (original) The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against cybervandalism.

Claim 16. (original) The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against denial-of-service attacks.

Claim 17. (original) The system of secret internet web sites of Claim 14 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of said system from all but those users who have been given the knowledge thereof by said operator.

Claim 18. (original) The system of secret internet web sites of Claim 14 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL to subscribing users.

Claim 19. (original) The system of secret internet web sites of Claim 14 wherein a reserve of secret sites is maintained that become available to the users of internet operation served by such a system in the event of an emergency created by an attack.

Claim 20. (currently amended) An internet operation including a system of secret internet web sites comprising:

(a) a plurality of one or more computers programmed to operate as a plurality of web servers;

(b) one or more of said web servers hosting internet web sites for said internet operation;

(c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;

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(d) one or more of said internet web sites being secret sites having URLs which are not publicly

associated with said internet operation; wherein each of said secret sites have a URL which:

1. is maintained as a secret from all but those users who have been given the knowledge
thereof by the operator; and

2. is assigned to a user upon the user's request and in response to the user providing means
by which they can be sufficiently identified for purposes of the level of security
against attack desired by the operator;

and wherein the knowledge of the existence, identity and URL of each of said secret sites
is not available to the public except through a process requiring such identification of the
user;

said secret sites being a part of said internet operation by which said internet operation may be
accessed.

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